Hearing: Paper No. 26
May 27, 1997

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB AUG 6, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Automobile Club de l'Ouest de la France
v.
R. J. Reynolds Tobacco Company

Opposition No. 90,621
to application Serial No. 74/276,846
filed on May 18, 1992

Vincent F. Bick, Jr. for R. J. Reynolds Company.

Michael J. Striker of Striker, Striker and Stenby for Automobile Club de l'Ouest de la France.

Before Simms, Cissel and Seeherman, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On May 18, 1992, applicant, hereinafter referred to as "Reynolds," applied to register the mark "LEMANS" on the Principal Register for "cigarettes," in Class 34. The basis for the application was Reynolds' assertion that it possessed a bona fide intention to use the mark in commerce on these goods.

On December 14, 1992, a timely notice of opposition was filed by the Automobile Club de l'Ouest de la France, hereinafter referred to as the "Automobile Club." As grounds for opposition, opposer asserted that it is a French limited liability company which, for many years prior to the filing of the opposed application, organized, promoted and conducted the annual automobile race generally known throughout the United States as "LeMans" or "The 24 Hours of LeMans"; that the race, which is promoted in the United States, is, in the United States, the first or second most well known automobile race, even though it takes place in France; that the mark "LE MANS" is famous in the United States in connection with opposer's race; and that applicant's mark, if used for cigarettes, would so resemble opposer's famous mark that confusion would be likely. Additionally, opposer stated in the notice of opposition that because cigarette smoking is a direct cause of cancer, heart disease and numerous other ailments, opposer will be damaged if its famous trademark is used in connection with cigarettes.

In answer to the notice of opposition, Reynolds basically denied the allegations of the Automobile Club with regard to the likelihood of confusion, and asserted as an "affirmative defense" that applicant had owned Registration No. 980,683, issued on March 26, 1974, for the mark "LEMANS"

for cigarettes, based on use since February 1, 1973, but that the registration was subsequently canceled voluntarily; and that third-party use and registration of "LE MANS" and terms incorporating it or equivalent to it should result in the Board's according a very narrow scope of protection to opposer's mark and holding that confusion would not be likely if applicant were to use the mark on cigarettes.

A trial was conducted in accordance with the Trademark Rules of Practice, briefs were filed by both parties, and an oral hearing was held before the Board on May 27, 1997.

The record includes the testimony, with exhibits, of Jacques Grelley[1], a retired race car driver who raced at LeMans and in other professional races; of Ruth O'Brien, an administrative assistant at the Automobile Club's law firm; and of Anne Miller, an employee of Reynolds. Also of record, by notices of reliance, are various publications relating to the fame of opposer's auto race, and two registrations owned by opposer. Reg. No. 1,332,791 issued on April 30, 1985 for the mark "LES 24 HEURES DU MANS," which translates into English as "THE 24 HOURS OF LE MANS." The goods and services listed in the registration when it issued were as follows: "automobile oil and lubricants," in

[1] Certain of the exhibits to the testimony of Mr. Grelley were never received by the Board. Upon inquiry, neither opposer nor applicant was able to locate duplicates, so opposer submitted a statement that it is not relying on the missing exhibits to this testimony.

Class 4; “ignition wires, points, plugs and condensers for use on land vehicle engines,” in Class 7; “internal combustion engines for land vehicles; automobiles, automobile tires,” in Class 12; “single work books and playing cards relating to automobile racing,” in Class 16; “key rings, primarily not of metal,” in Class 20; “dishes,” in Class 21; “clothing-namely, jackets, scarves and hats,” in Class 25; “equipment sold as a unit for playing a board game relating to automobile racing,” in Class 28; “ashtrays,” in Class 34; and “organization and presentation of automobile races,” in Class 41. In 1991, the goods and services in the following classes were canceled under Section 8 of the Act: 4, 7, 12, 21, 28, and 41. The registration remains in effect, therefore, with respect to, among other things, “ashtrays” in Class 34.

Reg. No. 1,393,543, issued on May 13, 1986, for the mark shown below

for “organization and conducting of automobile races,” in Class 41. Affidavits under Sections 8 and 15 of the Act were timely filed with respect to this registration.

After careful consideration of the record in this proceeding and the arguments on behalf of the parties, we find that the mark "LE MANS" is famous for the service of organizing and conducting the Automobile Club's international automobile competition, and that, in view of both the practice of opposer of using and registering its mark on collateral merchandise, as well as the established commercial relationship between automobile racing and cigarettes, confusion would be likely if applicant were to use "LEMANS" as a trademark for its cigarettes. We agree with opposer that consumers presented with the mark on cigarettes would be likely to assume that some sort of consent from the Auto Club allows the use of its famous mark by Reynolds. Whether such consent would be presumed to be in the form of a license, endorsement, sponsorship, or some other type of permission is not important. The association between applicant and opposer would be mistakenly assumed to exist.

We are not led to a contrary conclusion by either the relatively small amount of use by third parties of marks consisting of or incorporating "LE MANS" or variations thereof in connection with services which are unrelated to cigarettes, or the fact that applicant once was issued a now defunct registration for this mark in connection with the same goods specified in the opposed application.

The evidence and testimony of record in this proceeding constitute a persuasive showing that the mark "LE MANS" is famous in the United States for organizing and conducting the Automobile Club's annual race in France. The publicity and renown of the race in this country is clear from the testimony of Mr. Grelley and Ms. O'Brien, as well as from the encyclopedias and periodical publications made of record by the notice of reliance of opposer. The Automobile Club has conducted its race since 1923, and it is televised and known here and throughout the world as one of the most prestigious events in the world of motorsports.

The record which demonstrates the fame of opposer's mark also shows that a commercial association exists between auto racing and cigarettes. Racing cars and teams are often sponsored by tobacco companies, which capitalize on the publicity accorded to the cars and their drivers in order to promote the sale of their cigarettes. The glamour and excitement associated with car racing seem to generate sales for these products. The evidence shows that "Rothmans," "Camel," "Winston," "Lucky Strike" and "Silk Cut" brand cigarettes are all promoted in this way.[2]

[2] Opposer's pleading and argument that it fears it would be damaged if its mark were used by applicant on cigarettes because they cause numerous diseases appear to be disingenuous in view of what the record shows in this regard. Opposer itself has registered its mark for ashtrays. If the association between racing and tobacco were in fact so odious, such use and registration, as well as the widespread sponsorship of cars and advertising on them by tobacco companies would not be tolerated,

This record also clearly establishes that the Automobile Club, as the entity which organizes and conducts the automobile races under the marks "LE MANS" and "THE 24 HOURS OF LE MANS," has used and registered the latter for a wide range of collateral products, including clothing, key rings, books, car parts, dishes, board games and, significantly, ashtrays.

In view of the commercial association between tobacco products and auto racing, as well as the fame of opposer's mark and its use and registration of it in connection with collateral products, including ashtrays, which, of course are used in direct connection with cigarettes, consumers would be likely to assume that cigarettes bearing the Automobile Club's mark are endorsed, sponsored, or somehow affiliated with the Automobile Club.

The facts of this case and our reasoning in resolving it are similar in many respects to the situation in K2 Corporation, et al, v. Philip Morris Incorporated, 192 USPQ 174 (TTAB 1976); affirmed by the Court of Customs and Patent Appeals at 555 F.2d 815, 194 USPQ 81 (CCPA 1981). In that case, confusion was found to be likely in view of the use of the mark "K2" on both cigarettes and skis. The tobacco company sponsored ski races, and we held that consumers would likely assume a connection or association between the

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either by the racing teams themselves, or by the tracks at which

cigarettes and skis when the same mark was used on both. In a similar sense, in view of the sponsorship of race cars and teams by tobacco companies, smokers presented with cigarettes bearing this famous mark for auto racing would be likely to assume that some association, endorsement or sponsorship from the racing organization permits the use of the mark on the tobacco products.

Our conclusion in the case at hand on this issue is not, however, based on the testimony of opposer's witness Mr. Grelley with regard to the Harley Davidson brand cigarettes he purchased. Although opposer seems to contend that his testimony establishes a basis for consumers to expect famous marks for other products to be used under license for cigarettes, Mr. Grelley did not testify that these goods were marketed under license from the motorcycle manufacturer. For that matter, his testimony does not even indicate that he assumed that the cigarette maker had permission from the motorcycle company to use the motorcycle trademark. All he actually said was that he had purchased the pack bearing the Harley Davidson trademark at a gas station in Dallas, but that he had stopped smoking years earlier at the order of his doctor. Neither counsel for opposer nor applicant's counsel inquired further of the witness on this subject. We do not know who is responsible

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they compete.

for the Harley Davidson trademark on these goods, much less whether there is any connection between the maker of them and the owner of the motorcycle trademark. This testimony falls short of establishing the connection that opposer sought to establish, and it is not the basis for our conclusion that confusion is likely.

Turning to applicant's weak mark theory, as opposer points out, the four trademark registrations submitted by applicant are not evidence of the use of these registered marks. Nor does the evidence of these third-party registrations for products such as hosiery, bicycles, luggage and telephones establish that the term has a recognized meaning in the field of conducting automobile races and collateral goods, such that opposer's mark should only be entitled to a smaller scope of protection.

Applicant further argues that the evidence of actual use by a relatively small number of businesses in the United States of marks consisting of or incorporating "LE MANS" also establishes that opposer's mark is weak, and that we should therefore conclude that confusion is not likely. We agree with opposer, however, that the uses shown by applicant are generally unrelated to tobacco products and appear to be de minimis in nature.

We note that the fact that Reynolds once owned a registration for this mark for the same goods specified in

the opposed application has no bearing on the resolution of this proceeding. That registration was voluntarily surrendered for cancellation, and whatever rights it represented were extinguished with it.

With regard to opposer's argument concerning applicant's intent, we have no direct evidence or testimony that Reynolds is simply attempting to enhance the marketability of its cigarettes by associating them with a famous and celebrated sporting event. This record does not establish any reason why applicant intends to adopt opposer's mark for use on its own products. We therefore cannot attribute bad intentions to applicant in this regard.

As discussed above, however, we do find that confusion would be likely if applicant were to use "LEMANS" as a trademark for cigarettes, primarily because of the fame of opposer's mark, its registration for collateral merchandise, and the association between automobile racing and tobacco products. Accordingly, we sustain this opposition, and registration to applicant is therefore refused.

R.L. Simms

R.F. Cissel

E.J. Seeherman
Administrative Trademark Judges,
Trademark Trial and Appeal Board